

REMARKS

By this amendment, claims 2, 7, 9, 16, 18, 20, and 22-24 have been amended.

Accordingly, claims 1-5, 7-12, and 14-24 are currently pending in the application, of which claims 1, 7, and 18-21 are independent claims.

Applicants respectfully submit that the above amendments do not add new matter to the application and are fully supported by the specification. Indeed, all of the present amendments are merely to clarify by correcting typographical errors in the previous version of the claims.

Entry of the Amendments and Remarks is respectfully requested because entry of Amendment places the present application in condition for allowance, or in the alternative, better form for appeal. No new matters are believed to be added by these Amendments. In view of the above amendments and the following Remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

Claim Comments

In the Office Action, Claims 2, 7, 9, 17-18, 20, and 22-24 commented on by the Examiner (p. 9, ¶ 13 of Office Action). Applicants thank the Examiner for noting these typographical errors.

Claims 2, 7, 9, 17-18, 20, and 22-24 have been amended to fix the typographical errors noted by the Examiner. These amendments are made for the sole purpose of correcting obvious typographical errors. This amendment is not made for the purpose of avoiding prior art, overcoming a rejection or objection, or narrowing the claimed invention, and no change in claim scope is intended. Therefore Applicants do not intend to relinquish any subject matter by these

amendments. Applicants respectfully submit that claims 2, 7, 9, 17-18, 20, and 22-24, as amended, no longer contain the identified typographical errors. Accordingly, Applicants believe that Examiner's comments should not be the basis for any future objection or rejection of these claims.

Rejections Under 35 U.S.C. §112, second paragraph

Claims 1-5, 7-12, 14-18, and 23-24 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite. Applicants respectfully traverse this rejection for at least the following reasons.

The Examiner asserts that "singly" is unclear. Applicants respectfully disagree, and note that the definition of singly is readily discernable. For example, claims 3-5 illustrate the meaning of "singly" in a similar context by means of contrast with "as a mixture." The Examiner seems to believe that because the layer in claim 1 is of the same compound (but only singly) as those in claims 3-5 (there the compound may be present singly or in a mixture), the layers must be the same. However, each of claims 3-5 uses the indefinite article to refer to the layer introduced in that claim. Accordingly it is clear in the claims that the described layer is not making an antecedent reference to the layer in claim 1. Accordingly, there is no contradiction or lack of clarity.

The Examiner also notes that Claim 16 contains an obvious typographic error. Applicants have amended Claim 16 to correct this error. Accordingly, this rejection has been rendered moot.

With regard to claim 18, the Examiner believes that the claim language is unclear. The Applicants have amended the claim language to clarify. In doing so, the Applicants are not adopting the Examiner's assertion that there are two definitions, but rather are removing unnecessary claim language. Applicants believe that the true meaning of the claim has always been what the Examiner describes as the narrower meaning, because the subsequent paragraph clearly modified the prior one. Nevertheless, in order to improve the aesthetics of the claim, the Applicants have eliminated the unnecessary language from the prior paragraph. Accordingly, the scope of the claim is unaffected by this amendment. However, it is understood that this amendment will clarify, and consequently that the rejection will be withdrawn.

The Examiner also notes that Claim 23 contains an obvious typographic error. Applicants have amended Claim 23 to correct this error. Accordingly, this rejection has been rendered moot.

The Examiner also notes that Claim 24 contains an obvious typographic error. Applicants have amended Claim 24 to correct this error, by removing the inadvertently added language "at least." Accordingly, this rejection has been rendered moot.

Claims 16, 23, and 24 have been amended to clarify the merely typographical errors. These amendments are made for the sole purpose of clarifying claims 16, 23, and 24. These amendments are not made for the purpose of avoiding prior art or narrowing the claimed invention, and no change in claim scope is intended. Likewise, the amendment to claim 18 is merely to clarify that claim, is not made to avoid prior art nor to narrow the claimed invention, and does not change the scope of the claim. Therefore, Applicants do not intend to relinquish

any subject matter by these amendments. Applicants respectfully submit that claims 16, 18, 23, and 24, as amended, fully comply with the requirements of 35 U.S.C. §112, second paragraph.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §112, second paragraph rejection of claims 1-5, 7-12, 14-18, and 23-24.

Rejections Under 35 U.S.C. §102

Claims 1-5 and 19-22 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application No. 2003/0134145 to Toguchi, *et al.* ("*Toguchi*"). Applicants respectfully traverse this rejection for at least the following reasons.

The Examiner notes that *Toguchi* has a common inventor. What the Examiner fails to note is that all of the inventors of *Toguchi* are inventors of the invention as presently claimed. Accordingly, *Toguchi* does not represent "an application for patent ... by another" as required by 35 U.S.C. §102(e). To put it slightly differently, as all of the inventors of *Toguchi* are inventors named in the present application, they could not have invented the invention before themselves. Applicants respectfully believe the Examiner's comment regarding inventive entity is misplaced, and Applicants decline to address whether the inventive entity is the same, because the presence of all the inventors for the allegedly prior art as inventors in the present application obviates such inquiry. Thus, *Toguchi* is not proper prior art with regard to the present invention.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §102(e) rejection of claims 1-5 and 19-22. Since none of the other prior art of record discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claims 1, 19, 20, and 21, and all the claims that depend from them are allowable.

Rejections Under 35 U.S.C. §103

Claims 1, 3-5, and 14-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,329,084 issued to Tamano, *et al.* ("*Tamano*") in view of no additional art. Applicants respectfully traverse this rejection for at least the following reasons.

At the outset, Applicants note that the Examiner incorporates referentially the reasons stated in the office action mailed June 9, 2003. Accordingly, Applicants thank the Examiner for again observing (this time by referential incorporation) that *Tamano* is insufficient as an anticipatory reference because it does not contain every element of the claims. In particular, the Examiner has noted that *Tamano* at least does not teach the specific compounds claimed.

As a preliminary matter, there is no cited reference to remedy the deficiencies of *Tamano*. Instead, the Examiner relies on the Examiner's own notions of what one of ordinary skill in the art would think. Indeed, the Examiner does not even assert that there is any teaching, suggestion, or motivation *in the art* to suggest the proposed modification which the Examiner alleges would read the claims. Instead, the Examiner relies on the unsupported assertion that to modify the structure of *Tamano* would have been obvious because one would also expect modifications to have similar properties.

There are, however, several flaws in the Examiner's argument. First, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In the present prosecution, the only teaching or suggestion to

make the claimed combination is in Applicants' disclosure. Accordingly, the rejection is improper.

Moreover, the rationale that the Examiner uses for modifying the reference is flawed. The Examiner asserts that the reason to modify the reference is that similar structures will likely yield similar results. Assuming, *arguendum*, that this is both true and relevant, it is not a reason for making a change. One seeking to produce the results taught by the reference would use the specific compounds taught by that reference because those presumably *do* produce the results claimed by the reference's author. There is no motivation to change something that presumably works.

Additionally, the Examiner's implied assertion that what is taught in the reference is the same as the presently claimed invention is not based in the claim language. In particular, the cited reference apparently addresses red light emitting materials. No such limitation is found in the claims of the present invention. Indeed, as indicated in the Summary of the Invention in the present application, "it is ... [a feature] of the present invention to provide an organic EL device[] ... by suppressing the concentration quenching." (p. 4, ll. 7-10). In contrast, the cited reference does not have any such object. Accordingly, one would certainly not have been motivated to modify the reference, and in particular to modify it to select a group having steric hindrance.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 1, 3-5, and 14-16. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention,

Applicants respectfully submit that independent claims 1 and 14, and all the claims that depend from them are allowable.

Rejections Under 35 U.S.C. §103

Claims 1, 3-5, and 14-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 11-144869 in view of no other art. Applicants respectfully traverse this rejection for at least the following reasons.

Under 35 U.S.C. § 103(c), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter in the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

The Examiner is respectfully directed to the following,

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. § 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR § 1.53(b), continued prosecution application filed under 37 CFR § 1.53(d), and reissues.

See Manual of Patent Examining Procedure (MPEP) § 706.02(I)(1) (8th Ed., Rev. Feb. 2003)

Applicants respectfully submit that at the time the invention was made, the invention was owned by the same person or subject to an obligation of assignment to the same person. More specifically, at the time the present invention was made, the present invention was owned by or

subject to an obligation of assignment to NEC Corp, which is the same assignee as recited in the cited reference.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 1, 3-5, and 14-16. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claims 1 and 14, and all the claims that depend from them are allowable.

Rejections Under 35 U.S.C. §103

Claims 1-5, 7-12, and 14-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 11-185961 in view of no other art. Applicants respectfully traverse this rejection for at least the following reasons.

Under 35 U.S.C. § 103(c), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter in the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

The Examiner is respectfully directed to the following,

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. § 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed

under 37 CFR § 1.53(b), continued prosecution application filed
under 37 CFR § 1.53(d), and reissues.

See Manual of Patent Examining Procedure (MPEP) § 706.02(l)(1) (8th Ed., Rev.
Feb. 2003)

Applicants respectfully submit that at the time the invention was made, the invention was owned by the same person or subject to an obligation of assignment to the same person. More specifically, at the time the present invention was made, the present invention was owned by or subject to an obligation of assignment to NEC Corp, which is the same assignee as recited in the cited reference.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 1, 3-5, and 14-16. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claims 1 and 14, and all the claims that depend from them are allowable.

Rejections Under 35 U.S.C. §103

Claims 1-3, 7-10, and 14-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 10-88120 ("*Okutsu*") in view of no other art. Applicants respectfully traverse this rejection for at least the following reasons.

At the outset, Applicants note that the Examiner incorporates referentially the reasons stated in the office action mailed June 9, 2003. Accordingly, Applicants thank the Examiner for again observing (this time by referential incorporation) that *Okutsu* is insufficient as an anticipatory reference because it does not contain every element of the claims. In particular, the Examiner has noted that *Okutsu* at least does not teach the specific compounds claimed.

As a preliminary matter, there is no cited reference to remedy the deficiencies of *Okutsu*. Instead, the Examiner relies on the Examiner's own notions of what one of ordinary skill in the art would think. Indeed, the Examiner does not even assert that there is any teaching, suggestion, or motivation *in the art* to suggest the proposed modification which the Examiner alleges would read the claims. Instead, the Examiner relies on the unsupported assertion that to modify the structure of *Okutsu* would have been obvious because one would also expect modifications to have similar properties.

There are, however, several flaws in the Examiner's argument. First, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In the present prosecution, the only teaching or suggestion to make the claimed combination is in Applicants' disclosure. Accordingly, the rejection is improper.

Moreover, the rationale that the Examiner uses for modifying the reference is flawed. The Examiner asserts that the reason to modify the reference is that similar structures will likely yield similar results. Assuming, *arguendum*, that this is both true and relevant, it is not a reason for making a change. One seeking to produce the results taught by the reference would use the specific compounds taught by that reference because those presumably *do* produce the results claimed by the reference's author. There is no motivation to change something that presumably works.

Additionally, the Examiner's implied assertion that the device taught in the reference is the same as the presently claimed invention is not based in the claim language. In particular, the

reference apparently discusses the successive lamination of various layers. No such limitation is found in the claims of the present invention. Indeed, as indicated in the Summary of the Invention in the present application, “it is ... [a feature] of the present invention to provide an organic EL device[] ... by suppressing the concentration quenching.” (p. 4, ll. 7-10). In contrast, the cited reference does not have any such object. Accordingly, one would certainly not have been motivated to modify the reference, and in particular to select a group having steric hindrance.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 1-3, 7-10, and 14-24. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claims 1, 7, 14, 18, 19, 20, and 21, and all the claims that depend from them are allowable.

Other Matters

Claims 1-5, 7-10, and 18-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over claims 1-17 of U.S. Patent No. 6,329,083 issued to Toguchi, *et al.* (“*Toguchi*”) under the judicially created doctrine of obviousness-type double patenting. Applicants respectfully traverse this rejection for at least the following reasons.

At the outset, Applicants note that the Examiner incorporates referentially the reasons stated in the office action mailed June 9, 2003. Accordingly, Applicants thank the Examiner for again observing (this time by referential incorporation) that the allegedly conflicting claims are not identical. The Examiner, however, asserts that they are not patentably distinct. The

Examiner appears to be asserting that there is a genus-species relationship between the claims of the cited reference and the claims of the present application. Applicants respectfully disagree that such a simplistic view is accurate. Accordingly, Applicants expect that this rejection will be withdrawn. However, if it is not, Applicants may elect to file a terminal disclaimer to advance prosecution.

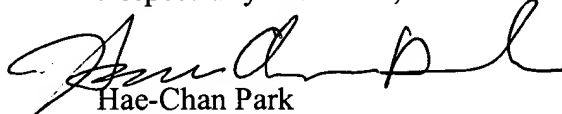
CONCLUSION

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicants' undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,



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